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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,149	10/12/2000	John J. Sie	19281-000900US	8623

20350 7590 01/16/2007

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EXAMINER	
BROWN, RUEBEN M	
ART UNIT	**PAPER NUMBER**
2623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/687,149	SIE ET AL.	
	Examiner	Art Unit	
	Reuben M. Brown	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15,18-20 and 23-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *18-20 and 23-25* is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/27/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/06 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/687,148, in view of Garfinkle, (U.S. Pat # 5,530,754). Although the conflicting claims are not identical, they are not patentably distinct from each other because 09/687,149, hereinafter referred to as '149 is obvious over 09/687,148, hereinafter referred to as '148.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Considering claim 1 of '149, the claimed method for 'distributing programming, comprising transmitting, by a content provider, a first set of programs in real time according to schedule of programming', corresponds directly with the similar recitation in the '148 application. However, the '149 application includes the additional limitation, 'by a content provider', which is not recited in the '148 application. It is pointed out that since the claimed subject matter is directed to the transmission of distributing programming, it would have been obvious for one of ordinary skill in the art to transmit the first set of programming from a content provider.

Regarding the feature recited in '149 of, 'storing a second set of programs on server located on a STB local to user, at least one of the first set of programs having a counterpart in the second set of programs, wherein the counterpart in the second set of programs is substantially identical to at least one of the first set of programs and is stored on the server at a substantially different time than the at least one first set of programs is transmitted', the subject matter corresponds with similar language recited in '148. However, the feature of the storing a set of programs on a STB local to a user, is not recited in the '148 application. Nevertheless, Garfinkle teaches storing at least a first portion of a plurality of movies on a STB, in catalog store 22 (col. 3; Fig. 4). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify application '148 with the feature of storing a set of programs on STB local to a user, as taught by Garfinkle, at least for the benefit of reducing the time needed for the user to begin viewing the movie, since at least the first portion of the movie would be retrieved locally, instead of over a network, as taught by Garfinkle (Abstract; col. 4, lines 12-34).

The further claimed feature recited'149 of, 'identifying when the user has tuned to a particular broadcast program having a counterpart in the second set of programs; transmitting a signal causing a notification symbol to be superimposed on the particular broadcast program to distinguish the particular broadcast program from the other broadcast programs not on the server; and playing the identified counterpart from the server from its beginning and under control of the user', corresponds directly with subject matter recited in '148.

The '148 application includes the additional feature of, 'transmitting an interface selectable by the user to restart the particular broadcast program'. This feature is not recited in the present '149 application.

Allowable Subject Matter

4. Claims 1- 15, 18-20 and 23-25 are allowed over prior art of record.

Both the Garfinkle and Russo references, relied upon in previous rejections teach a feature of storing a second set of movies on a STB local to a user. However, it is noted though that both Garfinkle & Russo are directed to a VOD arrangement, which is specifically different from the claimed, 'identifying when the user has tuned to a particular broadcast program having the counterpart in the second set of programs'. Furthermore, Garfinkle teaches that, "Along with the listing of the video products, conveniently an indication can be made as to whether or not the catalog store 22 includes for the product a trailer, a lead-in, a critic's review, or the like", col. 3, lines 59-62. However, this disclosure does not meet the amended claimed feature of, 'transmitting a signal causing a notification symbol to be superimposed on the particular broadcast to distinguish the particular broadcast program from other broadcast programs not on the server'.

Moreover, Ellis discloses a system, which enables a user to use trick-play operation with a selected broadcast program, such as Rewind (Para 0164-0166). At that point the user may be switched to streaming the identical content previously stored at the server, instead of the regular broadcast transmission. Fig. 11a (Para 0125) shows that an indicator may be placed on the title of a program to be transmitted, shown on an EPG screen, which will be cached at the server during broadcast.

However, applicant has argued that the present invention transmits the symbol superimposed on the transmitted broadcast program, not merely displaying the indicator data on the EPG, as taught by Ellis. Therefore, the presently amended claims recite subject matter that overcomes the Ellis reference.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ellis Teaches a client server system that stores broadcasted programs on a server and allows the user to access the stored program. Moreover, the reference teaches placing an indication o the EPG title of programs that indicates whether the program has a counterpart stored on the server.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:
(571) 273-8300, (for formal communications intended for entry)
Or:
(571) 273-7290 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown

REUBEN M. BROWN
PATENT EXAMINER